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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,987

08/31/2007

Michael Stockton

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EXAMINER

NIQUETTE, ROBERT R

ART UNIT

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3695

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,987	Applicant(s) STOCKTON ET AL.	
	Examiner Robert R. Niquette	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8-31-2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

This action is in reply to the application filed on 8-31-2007.

Claims 1-16 are currently pending and have been examined.

Priority

Acknowledgment is made of applicant's claim for a domestic priority date of 12-12-2003. The certified copy has been filed in parent Application No. 10581987.

Examiner's note: The examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the rest of the passage as taught by the prior art or disclosed by the Examiner.

Drawings

The drawings are objected because label 322 on Figure 4 has been used to designate both Enabling Transaction Information Matching and Facilitating Verification of Transaction Information. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each

Art Unit: 3695

drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1-8, based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class

Art Unit: 3695

to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The claims fail to tie the method to another statutory class (e.g. computer).

Amendment to add a tie to another statutory category of invention, such as a machine (e.g., computer) which performs a substantive method step is recommended to resolve the rejection under 35 U.S.C. 101.

Applicant did make a nominal recitation of uploading, however this alone does not tie the instant invention to an apparatus. It is a step which can function outside the scope of the invention. The balance of the limitations can be construed as human or mental steps which is nonstatutory matter.

Although claim 1 recites computer architecture in the preamble, this is insufficient to meet the statutory requirements. *Ex parte Langemyr* (BPAI No. 2008-1495, May 28, 2008) is quoted in pertinent part:

"The Appellants' claim 1 preamble includes only a nominal recitation of a 'computer.' Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, 'the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter.' Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989))."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under U.S.C. Title 35, §102(b) are rejected as being anticipated by US6058378, *Clark et al.*

As to claim(s) 1 and 9, *Clark* teaches:

uploading an electronic copy of a payment contract upon which an international trade receivables transaction is dependent (At least column(s) 3, lines 56-59, column 19, lines 38-41 and column 25, lines 3-5);

selecting documents comprised by said portfolio (At least column(s) 19, lines 4-8 and column 21, lines 18-23);

performing system-managed verification of required documents in said portfolio (At least column(s) 21, lines 14-23 and lines 60-67);

Art Unit: 3695

bundling said documents comprised by said portfolio whereby an association is provided between said documents (At least column(s) 2, lines 52-56 and column 22, lines 63 to column 23, line 5);

enabling a disposition of said documents comprised by said portfolio to be denoted as being discrepant or acceptable (At least column(s) 19, lines 14-26);

enabling a description corresponding to a corresponding discrepancy to be specified (At least column(s) 19, lines 14-26); and

enabling revised versions of discrepant portions of said documents to be individually re-submitted to the designated recipient whereby documents denoted as being acceptable need not be resubmitted (At least column(s) 19, lines 14-26).

As per claim(s) 2 and 10, *Clark* recites:

systematically extracting information from the payment contract and populating fields of system-populated documents comprised by said portfolio with said information, wherein said information is provided in the electronic payment contract in a system-extractable format (At least column(s) 19, lines 32-40 and lines 63-64)

In reference to claim(s) 3 and 11, *Clark* discusses:

at least a portion of said documents are system-mandated documents dependent upon at least one of a type of the international trade transaction and a type of the payment contract (At least column(s) 3, lines 10-14, column 25, lines 3-6 column 30, lines 1-10 and 13-16).

Regarding claim(s) 4 and 12, *Clark* discloses:

said system-managed verification is performed dependent upon at least one of a type of the international trade transaction and a type of the payment contract (At least column(s) 19, lines 23-27, column 21, lines 14-17 and lines 60-67).

With respect to claim(s) 5 and 13, *Clark* describes:

determining a required condition associated with settling the international trade receivables transaction (At least column(s) 32, lines 52-56); and

associating the required condition with a plurality of said documents whereby a reference to the condition is provided on each one of said documents

when said documents are outputted (At least column(s) 32, lines 52-56).

Concerning claim(s) 6 and 14, *Clark* teaches:

the international trade receivables transaction is one of a plurality of international trade receivables transactions to be settled under a common payment contract (At least column(s) 2, lines 52-56, lines 61-63 and column 3, lines 5-8); and

a first system-managed instance of said international trade receivables transactions serves as a template for each subsequent system-managed instance of said international trade receivables transactions, whereby consistency in content and accuracy between each said system managed instance is provided for (At least column(s) 2, lines 52-56, lines 61-63 and column 3, lines 5-8).

As per claim(s) 7 and 15, *Clark* recites:

the association includes a current revision level of each one of said documents (At least column(s) 2, lines 52-56, lines 61-63 and column 3, lines 5-8).

As to claim(s) 8 and 16, *Clark* discusses:

systematically extracting information from the payment contract and populating fields of system-populated documents comprised by said portfolio with said information (At least column(s) 8, lines 14-17, Column 19, lines 37 and 38, and column 21, lines 56-59);

determining a required condition associated with settling the international trade receivables transaction (At least column(s) 32, lines 52-56); and

associating the required condition with a plurality of said documents whereby a reference to the condition is provided on each one of said documents when said documents are outputted (At least column(s) 32, lines 52-56);

wherein said information is provided in the electronic payment contract in a system-extractable format (At least column(s) 19:28-40);

wherein at least a portion of said documents and data are system-mandated documents and data dependent upon at least one of a type of the international trade transaction and a type of the payment contract (At least column(s) 2, line 34 to column 3, line 32);

Art Unit: 3695

wherein said system-managed verification is performed dependent upon at least one of a type of the international trade transaction and a type of the payment contract (At least column(s) 19, lines 23-24, column 21, lines 14-23 and lines 60-63).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5424938 A	<i>Wagner; Christopher L. et al.</i>
US 5710889 A	<i>Clark; Barry Alan et al.</i>
US 20040260648	<i>Carlos, Fides et al.</i>
US 20040024692	<i>Turbeville, Wallace C. et al.</i>
US 20030040990	<i>Lee, Yeun-Jong et al.</i>
US 20030023527	<i>Wilce, Scot D. et al.</i>
US 20020178021	<i>Melchior, Peter et al.</i>
US 20020120570	<i>Loy, John J.</i>
US 20020099655	<i>Melchior, Peter et al.</i>
US 20020095373	<i>Melchior, Peter et al.</i>
US 20020095355	<i>Walker, David et al.</i>
US 7475037 B2	<i>Carlos; Fides et al.</i>

Art Unit: 3695

US 7383233 B1	<i>Singh; Vikram et al.</i>
US 7249069 B2	<i>Alie; Jason D. et al.</i>
US 7155409 B1	<i>Stroh; Leslie</i>
US 7082412 B1	<i>Treider; Kevin C. et al.</i>
US 6460020 B1	<i>Pool; Ed et al.</i>
US 6151588 A	<i>Tozzoli; Guy Frederick et al.</i>
US 5732400 A	<i>Mandler; Maria M. et al.</i>
US 5717989 A	<i>Tozzoli; Guy Frederick et al.</i>
US 5694552 A	<i>Aharoni; Amos</i>
US 20040019560	<i>Evans, Scott L. et al.</i>
US 20020049671	<i>Trende, Robert G. et al.</i>
US 20010034720	<i>Armes, David</i>
US 7236950 B2	<i>Savage; Patrick et al.</i>
US 7206768 B1	<i>deGroeve; Bernard et al.</i>
US 6996542 B1	<i>Landry; George W.</i>
US 5890140 A	<i>Clark; Barry Alan et al.</i>
US 7340433 B1	<i>Kay; Alan et al.</i>
US 7069234 B1	<i>Cornelius; Richard D. et al.</i>

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Niquette whose telephone number is 571-270-

Art Unit: 3695

3613. The examiner can normally be reached on Monday through Thursday, 5:30 AM to 4:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert R. Niquette/
Examiner, AU 3695
8-31-2009

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 3695